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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,426	06/28/2000	RICHARD HILICKI	HEH-2	6100
1473	7590	11/03/2004	EXAMINER	
FISH & NEAVE LLP 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/606,426

Applicant(s)

HILICKI ET AL. *CN*

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10-33, 35-37, 39-58, 60, 61, 63 and 65-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10-33, 35-37, 39-58, 60, 61, 63 and 65-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/2/04

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8, 10-33, 35-37, 39-58, 60, 61, 63, 65-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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1. In Claims 1 and 44, it is not understood how an image can be “displayed in at least one or more of said one or more coin receivable apertures”, without the aperture being covered on one surface or side of the cover. Applicant must further disclose what is supporting the “image” indicia. If there is a “support means” which holds the image in the aperture, then the aperture is actually a “recess” or “pocket” not an “aperture”.

2. In Claim 33, which is dependent from Claim 1, it is not understood how “one or more apertures” can be located on an “interior” side of at least one of the book covers if the “apertures” are located on “the exterior” of the book covers as stated in Claim 1, lines 6 and 7.

3. In Claim 58, which is dependent from Claim 44, it is not understood how “one or more apertures” can be located on an “interior” side of at least one of the book covers if the “apertures” are located on “the exterior” of the book covers as stated in Claim 44, lines 6 and 7.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6, 8, 10-33, 35, 37, 40-58, 60-63, 65-68 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 80, 81, 83-85, 87-89 of copending Application No. 10/273,898 in view of Pliler et al and further in view of Miller et al.

Both applications discloses a book having a theme and capable of displaying one or more coins; a first book cover; a second book cover joined to the first book cover; a plurality of sheets fastened together bound to book cover; a cap (or coin replica) insertable into and removable from the coin-receivable aperture; and wherein the cap displays an image related to the theme.

However, Hilicki et al et al ('898) does not disclose: wherein the exterior of one of the book covers defines one or more coin receivable apertures, wherein an image related to the book theme is displayed in the coin receivable aperture; and wherein the book theme is displayed on at least one of the book covers; a book theme relating to a geographic region, province, or a group of

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countries, or a fictional/non-fictional story; wherein one of the covers is made from card stock; and a cap with an image related to an image of a coin, a flag, flower, capitol and bird.

Pliler et al discloses in Fig. 1-3, a cover (12) comprising at least one aperture defined on the exterior side of one of the covers and not defined on the interior surface of the cover.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hilicki et al et al's book with an aperture defined on the exterior of the book cover as taught by Pliler et al for the purpose of displaying a coin or cap in an attractive and secure manner.

However, Hilicki et al et al as modified by Pliler does not disclose: wherein an image related to the book theme is displayed in the coin receivable aperture; and wherein the book theme is displayed on at least one of the book covers; a book theme relating to a geographic region, province, or a group of countries, or a fictional/non-fictional story; wherein one of the covers is made from card stock; and a cap with an image related to an image of a coin, a flag, flower, capitol and bird.

Miller discloses in Fig. 1-5, a book comprising a first book cover (A) and a second book cover (B) wherein the second book cover defines coin receivable apertures (C) for receiving coins (caps) in which the diameter of the aperture is substantially equal to that of the coin, and wherein the book theme relates to a geographic region and is displayed on one of the covers (D in Fig. 2) and in the apertures (Fig. 1). The method of generating a book is also inherently taught by Miller et al.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hilicki et al et al's and Pliler book with a coin receivable aperture defined having an image related to the theme displayed in the coin receivable aperture as taught by Miller for the purpose of defining the appropriate coin which is to be placed in the aperture.

In regards to **Claims 1-6, 11-17, 22-32, 35, 40-42, and 44-67**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired indicia on the cover, sheet or caps, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Therefore, it would have been obvious to incorporate any desired indicia in the Hilicki et al et al reference as a means to increase its display and marketability.

In regards to **Claims 43 and 68**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the covers with any desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Applicant has not disclosed that a particular material incorporated in covers is critical to his invention and the

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invention would equally as well with the material of Hilicki et al et al's cover or any alternative material as desired by an end user.

This is a provisional obviousness-type double patenting rejection.

### *Response to Arguments*

5. Applicant's arguments filed on March 4, 2002 have been fully considered but they are not persuasive.

After further review and consideration, the examiner has withdrawn the allowable subject matter stated in the previous office action.

In response to applicant's argument's that the prior art does not disclose placing the coin receivable apertures in the exterior of at least one of the covers, the examiner submits that the Pliler is now cited for disclosing an aperture on an exterior cover of a book, and that the Miller reference is now used to disclose an aperture having a displayed image. If applicant suggests that the cover displays an image on a support means, which is separately attached from the apertured cover, the examiner would submit that it would have been obvious to one having ordinary skill in the art at the time the invention was made to separate the apertured cover and image support means into two separate substrate layers, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Applicant has not

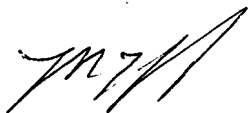


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disclosed that separating the cover into two layer is critical to his invention and the invention would equally as well if the apertured cover layer and image support layer were formed as one layer, since the aperture is blocked by the image, which in turn changes the "aperture" into a pocket or recess.

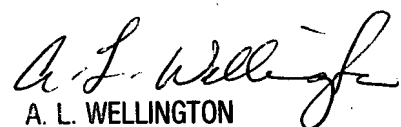
#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

October 25, 2004



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